

REMARKS

The specification has been amended to correct typographical errors. No new matter is introduced by way of this amendment.

Figures 5A and 5B have been amended to more accurately reflect the invention as described in the specification and claims. One sheet of formal drawings is presented herewith for approval.

Support for the amendments to Figure 5A is found, for example, in the specification at page 7, lines 3-4, and page 8, lines 22-24. Support for the amendments to Figure 5B is found, for example, at page 7, lines 3-4, and page 8, lines 24-25. Thus, no new matter is believed to be added.

Consideration of the above-identified application in view of the above amendments is respectfully requested.

Restriction Requirement

The Examiner has restricted the application between Group I (claims 1-12) directed to a power module and Group II (claims 13-18) directed to a method of manufacturing a power module. As noted above, Applicants elect the claims of Group I, and respectfully traverse the Restriction Requirement for the reasons set out immediately below.

Restriction Can Be Proper In Limited Circumstances.

An application may properly be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either *independent* or *distinct*. If a search and examination of an entire application can be made *without serious burden*, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803. In referring to practice under 35 U.S.C. 121, the MPEP notes “it becomes very important that the practice under this section be carefully administered,” and goes on to state “IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.” MPEP 803.01 (Emphasis in original). The concern is that the public should be able to rely on the assumption that upon expiration, the public will be free to use not only the invention claimed in the patent, but also modifications and variants thereof. MPEP 804.

The term “distinct” means that two or more subjects as disclosed are related, but are capable of separate manufacture, use, sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). MPEP 802.01 (Emphasis in original). In the subject application, the Examiner summarizes the applicable standard stating that the “inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process.” To support the contention that inventions are distinct, the Examiner states that “[i]n the instant case unpatentability of the group I invention would not necessarily imply unpatentability of the group II invention, since the device of group I invention, for example, instead of mounting a number of high side switches to the high side of the substrate, mounting a number of low side switches to the low side of the substrate beforehand would result in the same structure.” (Emphasis added.)

The Examiner appears to be asserting that the basis for the restriction is that the structure of claim 1 would result whether one 1) attached the low side switches before the high side switches, or 2) attached the high side switches before the low side switches. Applicants respectfully point out that method claim 13 does *not* expressly or implicitly set out any order for performing the acts stated therein. Unless the application expressly (*e.g.*, first, then, after, following) or implicitly (*e.g.*, acting on the results of a previous act or step) sets out an order, the mere listing of acts or steps in a method claim does *not* recite a specific order. Consequently, claim 13 reads on mounting the high and low side switches in *any* order.

The Examiner Has Not Met Initial Burden.

It is further noted that the burden is on the Examiner to provide *reasonable* examples that recite material *differences*. MPEP 806.05(e). As discussed above, the example presented by the Examiner does not appear to recite any material differences since claim 13 does *not* recite a specific order for mounting the switches.

The Claims Are So Related As To Present No Serious Burden To The Examiner.

Applicants’ Attorney is unable to discern how searching the entire application would present a *serious burden* to the Examiner. By entering the Restriction Requirement, the Examiner is contending that while searching the power module structure (*i.e.*, claim 1) in art class 257, subclass 691, she would not also search art class 438, subclass 15, that covers methods

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of forming the power module structure (i.e., claim 13). Likewise, the Examiner would not search the art class 257, subclass 691, covering power module structures when analyzing the method claims.

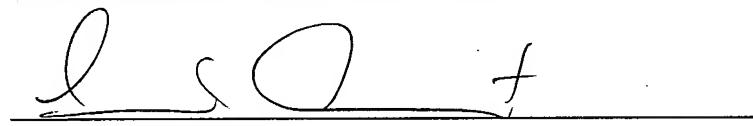
This contention leaves the Applicants wondering whether acquiescing in the Restriction Requirement would result in an inadequate search of the art. From past experience, it is likely that in addition to art classes encompassing power module structures, the Examiner will look to art classes covering methods of forming power module structures, and *will* rely on references from such a class to reject the claims directed to the power module structure. Likewise, the Examiner *will* likely look to art classes encompassing methods of forming power module structures, and *will* rely on such art in rejecting apparatus claims in light of such methods.

Summary

In light of the foregoing remarks, the Applicants respectfully request that the Restriction Requirement be withdrawn and all pending claims examined.

The Director is authorized to charge any fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
Seed Intellectual Property Law Group PLLC



Frank Abramonte
Registration No. 38,066

FA:lrj

Enclosures:

Postcard

1 Replacement Sheet of Formal Drawings (Figs. 5A-5B)

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
(206) 622-4900
Fax: (206) 682-6031

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Amendments to the Drawings:

The attached sheet of drawings includes changes to Figures 5A and 5B. This sheet, which includes Figures 5A and 5B, replaces the original sheet including Figures 5A and 5B.

Attachment: 1 Replacement Sheet